REMARKS

Status of the Claims

- Claims 106-115, 117-119, 122-138, 140-142, 145-158, 162 and 163 are pending in the Application.
- Claims 106-115, 117-119, 122-138, 140-142, 145-158, 162 and 163 are rejected by Examiner.
- Claims 106, 129, 152 are amended by Applicants.

New Amendments

Applicants submit that the made amendments herein more positively recite that which the Applicants regard as their invention. The present RCE submittal provides clarifying amendments to Claims 106, 129 and 152. Applicants note that the amendments of the response dated April 11, 2005 have not been entered. However, Applicants continue to rely on the distinctions between the claimed invention and the previously cited art expressed in the response dated April 11, 2005.

To briefly re-iterate one distinction, U.S. Patent No. 5,715,403 to Stefik teaches:

> A key feature of the present invention is that *usage rights are permanently "attached" to the digital work.* Copies made of a digital work will also have usage rights attached. Thus, the usage rights and any associated fees assigned by a creator and subsequent distributor *will always remain with a digital work.* (Col. 6 lines 62-67).

Whereas, the claimed invention has no mandate that digital content always remains with the digital license. The present amendments to Claims 106, 129 and 152 reciting "the license store providing access to the one or more digital licenses separately from the requested digital content" clarifies the distinction in positive terms. In addition, amended Claims 106 and 129 recite "a rendering application by which the requested digital content is rendered" to further indicate that the digital content and the license are accessed and utilized separately.

Specification Support

Applicants note that Figure 3 and Figure 8 of the present specification depict an exemplary digital content package and a digital license respectively. Applicants submits that the specification defines the digital content package and digital license as two separate entities. Figure 4 of the specification depicts an embodiment which shows the digital package 12p (see Figure 3) accessible to the Rendering Application 34. Figure 4 also depicts the License Store 38, which stores licenses 16 (see Figure 8 and p. 24 lines 20-28), accessible to the License Evaluator 36.

Additionally, the digital content and digital license are treated as two separate entities retrieved at two separate instances according to the flow diagram of Figure 5A. As explained in the specification:

> Referring now to Fig. 5A, in one embodiment of the present invention, assuming the encrypted digital content 12 has been distributed to and received by a user and placed by the user on the computing device 14 in the form of a stored file, the user will attempt to render the digital content 12 by executing some variation on a render command (step 501).

(Page 21 lines 12-16).

> In one embodiment of the present invention, the digital content 12 is in the form of a digital file having a file name ending with an extension, and the computing device 14 can determine based on such extension to start a particular kind of rendering application 34.

(Page 22 lines 1-4).

> Preferably, such rendering application 34 examines the digital content 12 associated with the file name and determines whether such digital content 12 is encrypted in a rights-protected form (steps 503, 505). If not protected, the digital content 12 may be rendered without further ado (step 507). If protected, the rendering application 34 determines from the encrypted digital content 12 that the DRM system 32 is necessary to play such digital content 12. Accordingly, such rendering application 34 directs the user's computing device 14 to run the DRM system 32 thereon (step 509). Such rendering application 34 then calls such DRM system 32 to decrypt the digital content 12 (step 511). As will be discussed in more detail below, the DRM system 32 in fact decrypts the digital content 12 only if the user has a valid license 16 for such digital content 12 and the right to play the digital content 12 according to the license rules in the valid license 16.

(Page 22 lines 16-26).

> Referring again to Fig. 5A, and again discussing content rendering in one embodiment of the present invention, once the DRM system 32 has assumed control from the calling rendering application 34, such DRM system 32 then begins the process of determining whether the user has a right to render the

> requested digital content 12 in the manner sought. In particular, the DRM system 32 either locates a valid, enabling license 16 in the license store (steps 515, 517) or attempts to acquire a valid, enabling license 16 from the license server 24 (i.e. performs the license acquisition function as discussed below and as shown in Fig. 7).

(Page 25, lines 21-28).

Applicants submit that the present specification indicates that the computing device 14, having a rendering application 34, attempts to render the digital content 12p before the DRM system is asked to access the license 16 from the license store 38. Applicants submit that the digital content and the license are thus treated as separate entities (as in Figure 3 and 8) that are separately accessed in the method steps shown in Figure 5A. This is in distinction to the mandated permanent attachment of usage rights to the digital work as taught by Stefik.

Applicants submit that amended Claims 106, 129 and 152 patentably define over the cited art using positive language.

Claim Rejections Pursuant to 35 U.S.C. §103 (a)

Claims 106-109 stand rejected in a Final Office Action dated 1/11/2005 pursuant to 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,715,403 to Stefik in view of the Examiner's rationale. The Applicants respectfully traverse the rejection in light of the amendments to the claims.

Applicants rely on the fact that Stefik teaches a system for controlling use and distribution of digital works in which the digital work and user rights are permanently attached to one another. (See Stefik Col. 6 lines 62-67). In as much as this mandate in Stefik is diametrically adverse to the recitation of amended Claims 106, 129, and 152, Applicants submit that Stefik quite effectively teaches away from the present invention by requiring that digital works and user rights are permanently attached.

Applicants respectfully submit that Stefik does not teach or suggest, alone or in combination with the Examiners rationale, all the elements of amended Claims 106, 129 and 152. Specifically, the references, alone or in combination, fail to specifically teach or suggest, among other things, the license store storing the one or more digital licenses separately from the requested digital content. In distinction, Stefik relies on the permanent attachment of the

user rights and digital works and thus teaches away from the recitals of the above mentioned claims. Consequently, Stefik either alone or in combination with rationale, cannot render amended independent Claims 106, 129 and 152 obvious. As a result, these claims patentably define over the cited art.

The Examiner, in the Advisory Action dated 4/27/2005, states that Downs et al (US. Pat No. 6,226, 618) Figs. 1D shows a license store without digital content. Applicants thank the Examiner for providing this detail. Yet, Applicants believe that Downs et al. cannot anticipate amended Claims 106, 129 and 152 because Downs et al. fails to disclose all elements of the amended claims. In addition, in as much as Stefik does in fact teach away from the current invention because it mandates the permanent combination of digital works and user rights, then Stefik cannot be combined with any other reference that teaches otherwise. Applicants submit that a Stefik-based obviousness rejection of amended Claims 106, 129 and 152 would be improper because the it would result in a combination that renders completely un-usable the invention of Stefik and any second reference invention that teaches the separation of digital works and user rights. Therefore there can be no rational motivation to combine Stefik with any other reference in light of the amended claims because of the completely un-usable result.

Similarly, dependent Claims 107-115, 117-119, 122-128 which rely on amended independent Claim 106, dependent Claims 130-138, 140-142, 145-151 which rely on amended independent Claim 129 and dependent Claims 152-158, 162 and 163 which rely on amended independent Claim 152 are also rendered non-obvious and patentably define over the cited art.

Dependent Claims 110-112 stand rejected in a Final Office Action dated 1/11/2005 pursuant to 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,715,403 to Stefik in view of U.S. Patent No. 6,073,124 to Krishnan et al. Applicants respectfully traverse the rejection in light of the amendment to base Claim 106 and the above response concerning the explicit teaching away of the claimed invention as taught by Stefik and the un-usable result of the combination.

Dependent Claims 113-115, 117-119 and 121-128 stand rejected pursuant to 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,715,403 to Stefik in view of U.S. Patent No. 6,073,124 to Krishnan et al. and in further view of U.S. Patent No. 5,892,900

to Ginter et al. Applicants respectfully traverse the rejection in light of the amendment to base Claim 106 and the above response concerning the explicit teaching away of the claimed invention as taught by Stefik and the un-usable result of the combination.

Conclusion

Applicants submit that the current amendments to pending Claims 106, 129 and 152 traverse the explicitly stated 35 U.S.C. §103(a) rejections of the Final Office Action dated 1/11/2005 because of the teaching away of Stefik and because of the un-usable results from a combination of references containing Stefik. Consequently, Applicants respectfully request reconsideration and examination of all pending claims.

Respectfully Submitted,

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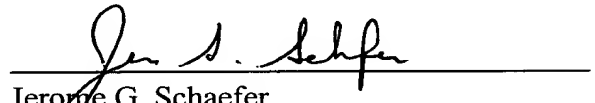

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